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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,110	10/22/2001	Patrizia Caldirola	13425-052001 / 00382-US	5944
26161	7590	07/26/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			MCKENZIE, THOMAS C	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/037,110

Applicant(s)

CALDIROLA ET AL.

Examiner

Thomas McKenzie, Ph.D.

Art Unit

1624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 15 July 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____


3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 32.Claim(s) objected to: 6-10,15-17,25,41-43,50-54,56 and 61.Claim(s) rejected: 1-5,11-14,18,22-24,28-30,33,34,36-40,44,46-49,54,55,59 and 60.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


Thomas C. McKenzie, Ph.D.
Examiner
Art Unit: 1624

uation of 3. Applicant's reply has overcome the following rejection(s): the indefiniteness rejection made in point #5 of the Final
tion and the enablement rejection made in point #6 of that rejection.

uation of 5. does NOT place the application in condition for allowance because: Applicants argue that there are no per se rules
rning the obviousness of position isomers and that there is no teaching or motivation supplied in Isaac (Bioorganic & Medicinal
istry Letters, ref ADD) to switch the point of attachment to the claimed positions 4 or 5 from the taught point of attachment at position
is is not persuasive for three reasons. Firstly if there were both teaching and motivation supplied by the reference, then it would be
ation not an obviousness rejection. Secondly, the medicinal chemist routinely prepares isomers of active compounds as a part of
e experimentation. The motivation is to explore the SAR, to prepare more active compounds, and at times to work around the prior
hirdly, In re Deuel 34 USPQ2d 1210 at 1214, Ex parte Englehardt 208 USPQ 343 at 349 ("position isomerism has been used as a
obtain new and useful drugs"), In re Mehta 146 USPQ 284 ("position isomerism is a fact of close structural similarity"), In re JONES
SPQ 152, In re NORRIS 84 USPQ 458, quoted with approval, Ex parte Ulyot 103 USPQ 185, also quoted with approval Ex parte
124 USPQ 109, Ex parte MOWRY AND SEYMOUR 91 USPQ 219, In re Surrey 138 USPQ 67, Ex parte Naito 168 USPQ 437 at 439,
sal of the position of the phenyl and lower alkyl groups on the isothiazole nucleus over prior art obvious. "This merely involves
on isomers and under the decisions cited, the examiner's holding of prima facie obviousness is warranted"), Ex parte Allais 152
Q 66 (claimed 3-b-aminopropyl-6-methoxyindole obvious over taught 3-b-aminopropyl-5 methoxyindole position isomer), Ex parte
el 130 USPQ 474, In re Crounse, 150 USPQ 554 (claimed compound with amide group attached at the para or 4-position and
oxy (-OCH3) group in the ortho, or 2-position obvious over taught compound with amide group attached at the meta, or 3-position
ethoxy group in the para position), In re Fouche 169 USPQ 429, Ex parte Ruddy 121 USPQ 427, In re Wiechert 152 USPQ 249, In
yne, Durden, and Weiden 203 USPQ 245 (1,4-dithiane obvious over taught 1,3-dithiolane, In re Wilder 195 USPQ 426 (claimed 2-
l pentyl position isomer obvious over taught 1-methyl pentyl compound), quoted with approval In re Grabiak 226 USPQ 870, .

Tom McElroy
7/22/04